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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/846,311      | 05/01/2001  | Ravesh Lala          | RSW920010070US1     | 4707             |

7590 04/27/2005

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| EXAMINER |
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VU, THONG H

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2142

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/846,311

Applicant(s)

LALA ET AL.

Examiner

Thong H. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. Claims 1-20 are pending.
2. Claims 1,2 recites the limitation "pointer" in wherein the associating is made explicitly by pointers that are included in terms of the promotions. There is insufficient antecedent basis for this limitation in the claim.

***Response to Arguments***

3. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. This is Non-Final Office Action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Eggleston et al [Eggleston 6,061,660].
5. As per claim 1, Eggleston discloses a method for enabling a web server to provide a commercial promotion [Eggleston, Weber server , an incentive program with award, col 6 lines 25-45, Fig1], comprising the act of:

detecting a qualifying value (i.e.: a prize, award, reward) of a commercial transaction [Eggleston, prompted to select prizes, col 14 line 66-col 15 line 15; col 19

lines 55-66; col 20 lines 33-67; monitoring behavior, col 39 lines 52-64; filtering, col 41 lines 5-25];

checking a database of promotions for presence of a promotion that includes the qualifying value [Eggleston, check to access database, col 40 lines 7-24; col 44 lines 5-63]; and

when a promotion that includes the qualifying value is present in the database, associating the qualifying value of the promotion with a module of selectively executable compiled web server code residing on a server's body of compiled code, selecting the module of selectively executable compiled web server code, and executing the module of selectively executable compiled web server code that provides the promotion [Eggleston, a database with incentive program, col 12 lines 12-18; 49-57; col 33 lines 38-52; select program associate with the predetermined type of reward, col 14 lines 25-50, col 15 lines 27-55, col 17 line 57-col 18 line 32, col 19 lines 1-67 col 20 lines 1-32, col 26 lines 1-22, 62-67, col 29 lines 20-37, col 30 lines 47-67 col 31 line 25-col 32 line 64, col 35 lines 38-47, col 36 lines 1-20, col 39 lines 28-50, col 41 lines 5-38].

wherein the associating is made explicitly by **pointers** that are included in terms of the promotions [Eggleston, a pointer, col 34 lines 1-20].

6. Claim 2 contains the similar limitations set forth of claim 1. Therefore, claim 2 is rejected for the similar rationale set forth in claim 1.

7. As per claims 3,13 Eggleston discloses the module is associated with the reward value by a pointer [Eggleston, a pointer, col 34 lines 1-20].
8. As per claims 4,14 Eggleston discloses the pointer is in the database [Eggleston, a pointer, col 34 lines 1-20].
9. As per claim 5, Eggleston discloses including the act of advancing a promotion counter in response to executing the module [Eggleston, paid in advance by the sponsoring firm, col 41 lines 5-26].
10. As per claims 6,15 Eggleston discloses the module is associated with the reward value implicitly [Eggleston, associate the award with the incentive program, col 157 lines 8-23].
11. As per claim 7, Eggleston discloses A method for enabling a web server to provide a commercial promotion, comprising the acts of:
  - detecting a qualifying value of a commercial transaction [Eggleston, prompted to select prizes, col 14 line 66-col 15 line 15; col 19 lines 55-66; col 20 lines 33-67; monitoring behavior, col 39 lines 52-64; filtering, col 41 lines 5-25];
  - checking a database of promotions for presence of a promotion that includes the qualifying value [Eggleston, check to access database, col 40 lines 7-24;col 44 lines 5-63];

when a promotion that includes the qualifying value is present in the database, determining whether the promotion that includes the qualifying value is active [Eggleston, current status of the prize in the database, col 21 lines 3-27; current incentive program, col 26 lines 30-61]; and

when the promotion that includes the qualifying value is active, determining a reward value of the promotion that includes the qualifying value [Eggleston, determine a win, col 26 lines 30-61; col 31 lines 25-col 32 line 20] and executing a module of selectively executable compiled code associated with the reward value [Eggleston, the generated code, col 32 lines 21-52].

12. As per claims 8,18 Eggleston discloses the act of determining whether the promotion that includes the qualifying value is active further includes the act of checking a start date [Eggleston, the beginning date and the ending date of the incentive program, col 33 lines 39-52].

13. As per claims 9,19 Eggleston discloses the act of determining whether the promotion that includes the qualifying value is active further includes the act of checking a stop date [Eggleston, the beginning date and the ending date of the incentive program, col 33 lines 39-52].

14. As per claims 10,16,20 Eggleston discloses the act of advancing a promotion counter in response to executing the module [Eggleston, paid in advance by the sponsoring firm, col 41 lines 5-26].

15. As per claim 11, Eggleston discloses a Programmable media containing programmable software for enabling a web server to provide a commercial promotion, the programmable software comprising the steps of:

detecting a qualifying value of a commercial transaction [Eggleston, prompted to select prizes, col 14 line 66-col 15 line 15; col 19 lines 55-66; col 20 lines 33-67; monitoring behavior, col 39 lines 52-64; filtering, col 41 lines 5-25];

checking a database of promotions for presence of a promotion that includes the qualifying value [Eggleston, check to access database, col 40 lines 7-24;col 44 lines 5-63]; and

when a promotion that includes the qualifying value is present in the database, executing a module of selectively executable compiled web server code that provides the promotion [Eggleston, determine a win, col 26 lines 30-61; col 31 lines 25-col 32 line 20; the generated code, col 32 lines 21-52].

16. As per claim 12, Eggleston discloses Programmable media containing programmable software for enabling a web server to provide a commercial promotion, the programmable software comprising the steps of:

detecting a qualifying value of a commercial transaction [Eggleston, prompted to select prizes, col 14 line 66-col 15 line 15; col 19 lines 55-66; col 20 lines 33-67; monitoring behavior, col 39 lines 52-64; filtering, col 41 lines 5-25];

checking a database of promotions for presence of a promotion that includes the qualifying value [Eggleston, check to access database, col 40 lines 7-24; col 44 lines 5-63];

when a promotion that includes the qualifying value is present in the database, determining a reward value of the promotion that includes the qualifying value [Eggleston, current status of the prize in the database, col 21 lines 3-27; current incentive program, col 26 lines 30-61]; and

executing a module of selectively executable compiled code associated with the reward value [Eggleston, determine a win, col 26 lines 30-61; col 31 lines 25-col 32 line 20; the generated code, col 32 lines 21-52].

17. As per claim 17, Eggleston discloses a Programmable media containing programmable software for enabling a web server to provide a commercial promotion, the programmable software comprising the steps of:

detecting a qualifying value of a commercial transaction [Eggleston, prompted to select prizes, col 14 line 66-col 15 line 15; col 19 lines 55-66; col 20 lines 33-67; monitoring behavior, col 39 lines 52-64; filtering, col 41 lines 5-25];

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checking a database of promotions for presence of a promotion that includes the qualifying value [Eggleston, check to access database, col 40 lines 7-24; col 44 lines 5-63];

when a promotion that includes the qualifying value is present in the database, determining whether the promotion that includes the qualifying value is active [Eggleston, current status of the prize in the database, col 21 lines 3-27; current incentive program, col 26 lines 30-61]; and

when the promotion that includes the qualifying value is active, determining a reward value of the promotion that includes the qualifying value and executing a module of selectively executable compiled code associated with the reward value [Eggleston, determine a win, col 26 lines 30-61; col 31 lines 25-col 32 line 20; the generated code, col 32 lines 21-52.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (571) 272-3896. The fax number for the organization where this application or proceeding is assigned is 703-872-9306

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Thong Vu**  
**Patent Examiner**  
**Art Unit 2142**

